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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/617,461  | 07/11/2003  | Bernd Matthes        | 03105/DKT01041      | 3246             |
| 7590  | 06/28/2004  |                      | EXAMINER            |                  |
| Catherine B. Martineau<br>BorgWarner Inc.<br>Suite 100<br>3800 Automation Avenue<br>Auburn Hills, MI 48326-1782 |             |                      | BONCK, RODNEY H     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3681                |                  |
| DATE MAILED: 06/28/2004   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/617,461             | MATTHES ET AL.      |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Rodney H. Bonck        | 3681                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 July 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,13 and 14 is/are rejected.
- 7) Claim(s) 4-12 and 15 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11 July 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/07/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

The following is a first action on the merits of application Serial No.10/617,461, filed July 11, 2003.

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

Receipt is acknowledged of the Information Disclosure Statement filed January 7, 2004. The cited documents have been considered.

(Note that the citation of the German document, "DE 35 34 759 C1", has been corrected to be -- DE 35 32 759 C1 --.)

### ***Drawings***

The drawings are objected to because the three figures under "Fig. 5" are not separately labeled in Arabic numerals (see 37 CFR 1.84). These figures should be labeled Fig. 5A, Fig. 5B, and Fig. 5C. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of

an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities: Reference to specific claim numbers (see line 6 of page 1 and line 4 of page 3) in the specification is objectionable because the claims can be amended or canceled during prosecution thereby rendering meaningless the original reference thereto.

Appropriate correction is required.

### ***Claim Objections***

Claims 4-12 and 15 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only and cannot depend from any other multiple dependent claim. See MPEP

§ 608.01(n). Accordingly, the claims 4-12 and 15 have not been further treated on the merits.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 13, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "in particular" (claims 1 and 13) renders the claims indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Claim 13 is considered indefinite and/or inaccurate in reciting that the friction lining "expands or contracts essentially continuously in the radial direction." As disclosed there does not appear to be any expansion or contraction of the friction lining except for axial compression of the lining during engagement of the clutch and expansion after release. It appears that the claim is intended to refer to a thickness increase rather than any expansion or contraction of the surface.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, insofar as definite, are rejected under 35 U.S.C. 102(b) as being anticipated by Loeffler('360). Loeffler discloses a disk having a core plate a' and friction linings b having an essentially planar surface. The friction lining exhibits at least one area c' of the surface that is raised in comparison to the planar surface. The raised area is formed unitarily with the remaining friction lining, and the raised area is surrounded by groove c.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Staub('978). Staub discloses a disk having a core plate 12 and friction linings 16 having an essentially planar surface 26. The friction lining exhibits at least one area 20 of the surface that is raised in comparison to the planar surface. The raised area is formed unitarily with the remaining friction lining

Claims 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Wemp('016). Wemp discloses a disk having a core plate 20 and friction linings 26. The thickness of the lining as a whole increases from the outside towards the inside.

Claims 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Gamble('682). Gamble discloses a disk having a core plate 12 and a friction lining 14. The thickness of the lining 14 increases from the outside towards the inside.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Whitelaw et al.('710) is cited to show the raised areas in Fig. 8 with adjacent grooves 25. Whitcomb('998) shows raised areas c. Whisler et al.('872) shows raised areas 26, rounded in Fig. 1A and flat in Fig. 4A. Russell('424) is cited to show the raised areas 30, 40, and 50 in Figs. 5, 6, and 7, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney H. Bonck whose telephone number is (703)-308-2904. The examiner can normally be reached on Monday-Friday 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (703)-308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Rodney H. Bonck  
Primary Examiner  
Art Unit 3681

rhb  
June 23, 2004